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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,926	11/13/2001	Dominic Dough-Ming Cheung	9623.381	5426
56020 7590 05/07/2007 BRINKS HOFER GILSON & LIONE / YAHOO! OVERTURE P.O. BOX 10395 CHICAGO, IL 60610			EXAMINER TINKLER, MURIEL S	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 05/07/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/993,926

Applicant(s)

CHEUNG ET AL.

Examiner

Muriel Tinkler

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3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 5-36 is/are pending in the application.
- 4a) Of the above claim(s) 24-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 24-36 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This application has been reviewed. Claims 3 and 4 have been cancelled.  
Claims 1, 2 and 5-36 are pending. The election/restriction and rejections are as follows.

#### ***Response to Amendment***

1. Changes made to the drawings, figure 2 and figure 6, have been accepted.
2. Changes made to the specification, as shown in the Remarks/Amendments dated February 22, 2007, on pages 2-4, have been accepted.

#### ***Response to Arguments***

3. Applicant's arguments, see pages 14-17, filed February 22, 2007, with respect to the rejection(s) of claim(s) 1, 2, 5-9 and 12-22 under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.  
However, upon further consideration, a new ground(s) of rejection is made in view of Davis under 35 U.S.C. 102(e).

4. Applicant's arguments filed February 22, 2007 in view of the 35 U.S.C. 103 rejection of claims 10 and 11 have been fully considered but they are not persuasive. It is not clear that GoTo.com was renamed Overture Services, Inc. Furthermore, GoTo.com was not Overture Services, Inc. at the time the Applicant's invention was filed. It is unclear how GoTo.com changed to Overture Services, Inc., if at all, and if

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intellectual property rights were maintained in the transfer from GoTo.com to Overture Services, Inc. The Applicant must provide additional proof to overcome this argument.

5. Applicant's arguments with filed February 22, 2007 in view of the 35 U.S.C. 102(b) rejection(s) of claims 1, 2 and 5-21 have been considered but are moot in view of the new ground(s) of rejection.

6. Claim 1 has been amended to include the substance of Claims 3 and 4 (now cancelled). Claims 3 and 4 have been rejected based on the discussion(s) found in the Office Action mailed on December 7, 2006.

7. Claims 2 and 5-21 have not been substantially changed. See the rejection(s) for these claims found in the Office Action mailed on December 7, 2006.

8. The Applicant argues that Claims 5 and 15 add further subject matter to the previous claim. Claim 5 states additional information such as, position the selected search listing at the best attainable rank. Claim 15 has been amended to include, a single desired rank for all search listings. The objection(s) to Claims 5 and 15 have been withdrawn.

9. Claim 14 has been amended. Claim 14 is now acceptable and will be treated on its merits.

10. Claims 21 and 22 have been renumbered. The objections to these claims have been withdrawn.

11. Claims 24-36 have been determined to include divergent subject matter. Claims 24-36 are therefore subject to an election/restriction requirement, see below.

12. The Applicant argues that Davis does not disclose the use of a bid cap. The Examiner disagrees. Davis does disclose the use of a bid cap as the current balance. Also, the Applicant's claims are not limited to someone, other than the advertiser, changing the bid amount(s).

13. Claims 1 and 19 have been amended to include the use of a tie condition. The Applicant argues that Davis does not teach the use of tie conditions. The Examiner agrees, however these arguments are moot in view of the new grounds of rejection, see below.

#### ***Election/Restrictions***

14. Group I. Claims 1, 2 and 5-23, drawn to a pay for placement method and database search system comprising storing search listings, receiving a bid (cap and rank), adjusting bid amounts and incrementing bid amounts in the event of a tie.

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15. Group II. Claims 24-36, drawn to a method for pay for placement database search system comprising storing search listings, receiving a bid (cap and rank), submitting a bid update, adjusting bid amounts and overwriting bid updates.

16. The inventions are distinct, each from the other because of the following reasons:

17. Inventions Group I and Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Group II does not include incrementing the bid amount in the event of a tie, while it contains all other portions of Group I. Also, Group II contains additional items such as submitting a bid update and overwriting the bid update. The subcombination has separate utility such as in Group II a tie condition may be acceptable. Also, Group II allows for the implementation of updates and overwriting current bids. This allows the user to change their bid at the last minute and allows the queue to recognize last minute changes to bids.

18. The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are

subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

19. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

***Claim Rejections - 35 USC § 102***

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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21. Claims 1, 2, 5-9, 12-21 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Davis et al. (US 6,269,361 B2).

22. The subject matter for claim 1 has changed. Claim 1 now incorporates the subject matter of claims 1, 3 and 4. Claims 1, 3 and 4 have been previously rejected. See the rejection(s) of claims 1, 3 and 4 in the Office Action mailed on December 7, 2006.

23. The subject matter for claims 2, 5-9, 12, 13 and 16-21 has not changed. Claims 2, 5-9, 12, 13 and 16-21 have been previously rejected. See the rejection(s) of claims 2, 5-9, 12, 13 and 16-21 in the Office Action mailed on December 7, 2006.

24. Claim 14 discusses the method of claim 13 further comprising: providing an error indicating if the desired rank is not a rank equal to one of rank 1, rank 2 and rank 3. Davis discusses receiving a notification options when certain key events occur, such as a change in position of the advertiser's listing, in column 13 (line 64) through column 14 (line 20).

25. Claim 15 discusses the method of claim 1 further comprising receiving a single desired rank for all search listings of an advertiser and adjusting the respective bid amounts for all search listings according to the desired rank and bid cap. Davis



discusses this in figure 9 (the version used for ranking listings) and column 19 (lines 18-37).

26. Claim 23 discusses the method of claim 1 wherein the search listings that have a keyword matching a keyword entered by a searcher are ordered using the respective bid amounts for the respective search listings and listed on a result list including at least some of the ordered listings. Davis discusses this in figure 2, the Abstract and Summary of the Invention.

***Claim Rejections - 35 USC § 103***

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

29. Claims 10, 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis in view of Fraser (US 6,560,580).

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30. The subject matter of Claims 10 and 11 have not changed. Claims 10 and 11 have been previously been rejected. See the rejections of Claims 10 and 11 in the Office Action mailed on December 7, 2006.

31. Claim 22 discusses the method of claim 1 wherein adjusting respective bid amounts comprises: if selected search listing is grandfathered search listing and if adjusting the respective bid amount for the grandfathered search listing produces an adjusted rank that exceeds the desired rank, leaving the bid amount unadjusted. Davis discusses the use of grandfathered listings, or saved bid amounts in column 6 (lines 16-34). The remainder of the subject matter covered under Claim 22 is discussed in claims 10 and 11. Claims 10 and 11 have been previously been rejected. See the rejections of Claims 10 and 11 in the Office Action mailed on December 7, 2006.

### ***Conclusion***

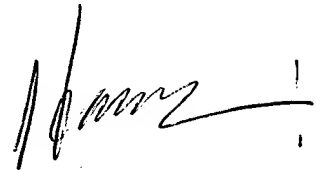
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muriel Tinkler whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 7:30 AM until 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT  
April 18, 2007

A handwritten signature in black ink, appearing to read 'H. Kazimi', with a long horizontal stroke extending to the right.

**HANI M. KAZIMI**  
**PRIMARY EXAMINER**